

REMARKS

Claims 27-29 and 32-52 are pending in this application. The specification has been amended. No amendments to the claims have been made. Reexamination and reconsideration of the application are respectfully requested.

Claim Objection

The Examiner has objected to claim 28 on the grounds that it is inconsistent with the specification. Claim 28 is an original claim and therefore is part of the original disclosure. Paragraph [0035] has been amended to incorporate the subject matter of claim 28 into the specification. Withdrawal of the objection is believed to be warranted and is respectfully requested.

Rejection under 35 USC § 112

Claims 27-29 and 32-52 has been rejected under 35 USC § 112, first paragraph, as based on a disclosure that is not enabling. This rejection is respectfully traversed.

The Examiner states that “[A] pattern of non-adhesive material providing a path for air egress from adhesive article is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure.” (emphasis original). Applicant respectfully submits that the characterization of air egress by the Examiner as “critical or essential” is contrary to the teachings in the Applicant’s disclosure. For example, the Applicant’s disclosure provides at paragraph [0019] the following:

[0019] As discussed above, the present invention relates to adhesive articles such as those used for industrial graphics. The adhesive articles provide one or more of air egress, repositionability and slidability for easy application to a substrate.

Air egress is only one of several different properties or advantages provided by the Applicant’s claimed adhesive articles. Air egress is not critical or essential.

The Examiner has also stated that “in the absence of a suitable thickness of the non-adhesive material, the claim 27 also appears to be unduly broad.” Although claim 27 is broad, it is fully enabled, and thus need not be narrowed.

An enabling disclosure for claims 27-29 and 32-52 is provided throughout the Applicant's specification, and in this regard the Examiner's attention is directed particularly to the Applicant's specification at paragraph 0054 and figures 4a and 4b. Applicant respectfully submits that 35 U.S.C. §112, first paragraph, requires nothing more than objective enablement. Whether this is achieved by use of illustrative examples or broad terminology is of no importance. *In re Marzocchi et al.*, 169 USPQ 367 (CCPA, 1971). An assertion by the Patent and Trademark Office that the enabling disclosure is not commensurate in scope with the protection sought must be supported by concrete reasons or evidence as to why the how-to-make and how-to-use requirements of the statute have not been met. No such reasoning or evidence has been offered. Applicant respectfully submits that the enabling disclosure provided in the present application is sufficient to support claims 27-29 and 32-52 and thus these claims need not be narrowed. Withdrawal of the rejection is believed to be warranted and is respectfully requested.

Conclusion

A notice of allowance is respectfully solicited. If it is determined that unresolved issues remain, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the application.

In the event any additional fees are due in connection with the filing of this paper, the Commissioner is authorized to charge those fees to our Deposit Account No. 18-0988 (Reference: AVERP2850US).

Respectfully submitted,

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By



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